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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,725	11/16/2000	Ying Luo	RIGL-008CIP	6653

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

1. The communication filed on August 29, 2006 in response to the Notice of Non-Compliant Appeal Brief mailed August 22, 2006 is acknowledged and has been entered.
2. The response does not remedy the defects cited in the Notice of Non-Compliant Appeal Brief mailed August 22, 2006 because although the Appeal Brief clearly refers to Figures 7 and 8 to support claims 26 and 29, respectively, this does not satisfy the requirements of 37 CFR 41.37(c)(1)(v) because the requirement clearly states that the brief must “contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal by referring to the specification by page and line number **AND TO THE DRAWINGS, IF ANY** (emphasis added)”. Since Appellant does not refer to the specification by page and line number, the requirements are not met.

Further, a review of claim 26 reveals that the claim is drawn to “A recombinant ING2 protein encoded by the contiguous polynucleotide sequence of nucleotides 120-845 of the nucleic acid set forth in SEQ ID NO:7.” Although Figure 7 reveals a sequence of 243 nucleotides, it is clear that the citation does not contain an explanation of the subject matter defined in claim 26 since it appears that, even if Figure 7 reveals some of the residues of the claimed sequence of nucleotides, it is missing 482 residues claimed. Further, the claim as currently constituted is not limited to ING2 proteins encoded by a nucleic acid sequence consisting of nucleotides 120-845 of SEQ ID NO:7, but rather is drawn to ING2 proteins encoded by nucleic acid sequences comprising the claimed nucleotides and the reference to Figure 7 does not provide a concise explanation of the broadly claimed subject matter.

In addition, a review of claim 29 reveals that it is drawn to “A recombinant ING2 protein, consisting essentially of the contiguous amino acid sequence set forth SEQ NO:8.” The MPEP states that “The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)” and “A consisting essentially of’ claim occupies a middle ground between closed claims that are written in a consisting of’ format and fully open claims that are drafted in a comprising’ format.” *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355 (“PPG could have defined the scope of the phrase consisting essentially of’ for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”). See also *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1240-41, 68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003).” Reference to Figure 8 does not provide a concise explanation of the broadly claimed subject matter, does not provide information drawn to the basic and novel characteristics

of the claimed invention or establish whether the term “consisting essentially of” is to be read as “comprising”.

3. Additionally, the Appeal Brief is defective because the Brief does not comply with the requirements of 37 CFR 41.37 because:

(A) The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), (37 CFR 41.37(c)(1)(iii)) as the Brief does not refer to claim 28.

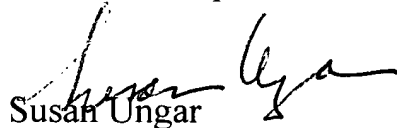
(B) The Grounds of Rejection to be Reviewed on Appeal section does not comply with 37 CFR 41.37(c)(1)(vi) because the Grounds of Rejection to be reviewed on appeal are not concisely stated. The section includes such statements as “If the Appellant's understanding of this eight page rejection is correct, the Examiner argues that”, “In attempting to establish this rejection, the Examiner argues that an mG2 protein that increases activity of a promoter having a p53 binding site” is not described”, “In a nutshell, the Examiner attempts to establish this rejection by arguing that one of skill in the art would not know which amino acids of SEQ ID NO:8”. 37 CFR 41.37(c)(1)(vi) requires that a concise statement of each ground of rejection be presented for review and specifically suggests language such as “Whether claims 1 and 2 are unpatentable under 35 USC 112, first paragraph, as being based on a non-enabling disclosure would comply with the rule.” In particular, the statement cannot include any argument concerning the grounds of rejection presented for review. It appears that Appellant, by stating Examiner’s arguments for rejection is, by inference, presenting arguments.

4. To avoid dismissal of the appeal, appellant must submit an appeal brief in compliance with the requirements of these sections within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is

longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or, (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (571) 272-0837. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787.


Susan Ungar

Primary Patent Examiner
November 20, 2006